

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed May 31, 2005. At the time of the Office Action, Claims 1-4, 6-14, 16-24, 26-34, and 36-64 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Allowable Subject Matter

Applicant notes with appreciation the Examiner's allowance of Claims 47, 55, and 63.

Section 103 Rejections

The Examiner rejects Claims 1, 6-11, 16-21, 26-31, and 36-40 under 35 U.S.C. §103(a), as being unpatentable over U.S. Publication No. 2002/0037744 issued to Bhatia et al. (hereinafter "*Bhatia*") in view of U.S. Patent No. 6,584,190 issued to Bressler (hereinafter "*Bressler*"). The Examiner rejects Claims 2-4, 12-14, 22-24, 32-34, 41-46, 48-54, 56-62, and 64 under 35 U.S.C. §103(a), as being unpatentable over *Bhatia* and *Bressler* and further in view of U.S. Publication No. 2002/0065064 issued to Griffith et al. (hereinafter "*Griffith*"). These rejections are respectfully traversed for the following reasons.

Once again, Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

The rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. For example, Independent Claim 1 recites generating ... an application level signaling message associated with a network session, wherein the message is communicated to a serving node such that the serving node is made aware of session activity of the mobile unit, and *determining*

¹ See M.P.E.P. §2142-43.

allowability of the session, through out-of-band communications, based on a service agreement without accessing external resources.

Applicant is pleased to see that the Examiner recognizes that neither *Bhatia* nor *Griffith* offer any architecture that offers these out-of-band capabilities. (See Current Office Action: page 3.) However, the Examiner has used *Bressler* to fill this void. Turning to *Bressler*, *Bressler* offers an architecture for communications of telephony control signaling over data networks. In particular, *Bressler* discloses: "...system 10 utilizes an SS7 network to exchange messages between network nodes to establish, maintain, and terminate telephony communications. Conventionally, SS7 messages are exchanged between network nodes over channels referred to as SS7 signaling links. According to SS7, signaling occurs out-of-band over dedicated links rather than in-band on voice channels between terminals to provide faster call setup times, more efficient use of voice circuits and channels, and support for additional services." (See *Bressler*, Column 3: lines 14-30.)

Applicant can understand the Examiner's logic in using this reference for the missing out-of-band limitation and it appears as though *Bressler* is analogous art. But, Applicant also directs the Examiner's attention to the function that is being provided by such out-of-band signaling. Specifically, the out-of-band signaling recited in the pending claims is being leveraged to determine *an allowability of the session based on a service agreement* without accessing external resources. Hence, the out-of-band signaling component of the present subject matter of Applicant's is not simply an add-on part that is somewhat arbitrary in its purpose. In contrast, the signaling is interacting with other elements of the claim to yield the desired result. The out-of-band signaling present in the rejected claims is used to evaluate the allowability of the session based on a service agreement. Such functions are simply not provided for in *Bressler*, as Applicant can attest: having reviewed *Bressler* in its entirety.

Furthermore, there is nothing in any other reference that provides this missing disclosure. Applicant urges the Examiner to recognize that the out-of-band concept should not be construed in a vacuum. The out-of-band signaling is entrenched in Independent Claim 1 because of the surrounding implicated operations (e.g. determining allowability, not accessing external resources, etc.). Hence, it would behoove the Examiner to focus on the integration of these elements in the context of out-of band signaling, as opposed to interpreting out-of-band signaling as a lifeless insignificant feature.

Because the references lack such signaling being used to determine the allowability of the session based on a service agreement, whereby external resources are not accessed, Independent Claim 1 is allowable over the proposed *Bhatia-Bressler* combination. Indeed, the Examiner, in essence, is lacking disclosure for all three of these elements, which are clearly outlined by Independent Claim 1. Hence, the Examiner has failed to meet his burden with respect to the third criterion of non-obviousness.

Independent Claims 11, 21, 31, 41, 49, and 57 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

ATTORNEY DOCKET NO.
062891.0510

PATENT APPLICATION
09/771,257

21

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,
BAKER BOTT S L.L.P.
Attorneys for Applicant


Thomas J. Frame
Reg. No. 47,232

Date: July B, 2005

Customer No. 05073